



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/883,501 Confirmation No.: 8690
Applicant : Jeffrey A. Bedell et al.
Filed : June 19, 2001
Title : System and method for run-time report resolution of reports that
include prompt objects
TC/Art Unit : 2176
Examiner: : Maikhanh Nguyen

Docket No. : 53470.003041
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Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why applicants believe that an appeal will succeed are set forth below.

This application was filed over four years ago on June 19, 2001. Applicants' initial claims were rejected based on section 103 over a single reference. It appears that the Office misunderstands what the claims cover. It asserts that the use of a prompt object during execution of a report would have been obvious without a proper motivation. The only reason given is that it would have allowed the user to provide information they want. That is not suggested anywhere in the reference cited and the Office fails to identify any other source to back up that blanket contention.

Despite clearly indicating the deficiencies in the proposed motivation to combine in the first Office Action, the Office continues to misapply its obligation to provide motivation to combine references.

In this case, claims 1-6, 8-12, and 14-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,963,939 to McCann et al. (“McCann”). Claims 7 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over McCann in view of U.S. Patent No. 6,569,205 to Poggi (“Poggi”). McCann discloses asking a customer a series of questions to determine a business solution for that customer. There is no disclosure or suggestion for doing so during the operation of a report instance. Applicants’ specification defines a report instance as “an actual execution of a defined report.” Specification, page 2, lines 17-18. Whatever is received by the server in McCann and initiated by the client is not a report instance.

McCann also does not disclose or suggest “gather[ing]...the one or more prompt objects referenced in the report.” The Office Action cites a sign-on button 562 in the login screen of Figure 45 to teach this feature. The sign-on button causes the server to receive the ID and password entered into the web page. The ID and password are merely answers to a prompt, and this action merely involves the transfer of data from one place to another. The ID and password themselves are not prompt objects. They do not each comprise a question to be asked of a user and at least one validation property. Thus, nothing about the sign-on button or the login screen of Figure 45 discloses or suggests gathering prompt objects. Furthermore, any prompts or objects involved in Figure 45 are not related to a report.

McCann also does not disclose or suggest “generat[ing] a resolution object containing the one or more questions from the one or more prompt objects gathered.” The Office Action argues that the Question Block Base Class 100 and Figures 58A-58V teach this feature. McCann

describes the Question Block Base Class 100 as including “a large Base Class of questions that may be posed to a user to identify user preferences.” McCann, col. 23, lines 30-34. Figures 58A-58V show such questions as “Who will be the primary user of this desktop?” Figure 58E.

However, the questions of Question Block Base Class 100 and Figures 58A-58V do not include questions from any prompt object included in report instance. While the Office Action contends that the ID 556 and password 668 prompts are prompt objects of a report instance, the questions of these prompts are not those that are gathered in the Question Block Base Class 100 or Figures 58A-58V. Conversely, the questions in the Question Block Base Class 100 and Figures 58A-58V do not correspond to prompts that are included in a report that is received by the server, as recited in the claims.

Finally, as acknowledged in the Office Action, McCann does not disclose or suggest “executing the report upon receiving answers from a user to the one or more questions in the resolution object.” The Office Action contends that this step is obvious, but fails to provide proper motivation to change McCann.

Thus, the Office Action has failed to set forth a *prima facie* case of obviousness for the claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action’s sole justification for modifying McCann has

absolutely nothing to do with the deficiencies of McCann. To properly modify McCann to correct for these deficiencies, the Office has the burden to show some motivation why providing those elements would have overcome some perceived problem with McCann. Any such motivation is completely lacking. Therefore, this is a clear example of improper hindsight.

The mere fact that users may be able to provide information does not mean that McCann necessarily would be modified to generate a report and use prompt objects as part of that process. The Office has the burden to show a suggestion or motivation found somewhere in the prior art regarding the desirability of the modification of McCann. See M.P.E.P § 2143.01; see also *In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Thus, an appeal on that basis will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by MicroStrategy when the grounds is so clearly improper.

Respectfully submitted,



Brian M. Buroker
Registration No. 39,125

Hunton & Williams LLP
1900 K Street, NW
Washington, D.C. 20006-1109
(202) 955-1500

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